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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,656	09/29/2003	Masahiko Murayama	030662-107	9022

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EXAMINER	
CHOWDHURY, TARIFUR RASHID	
ART UNIT	PAPER NUMBER
2871	

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/671,656	MURAYAMA ET AL.	
	Examiner	Art Unit	
	Tarifur R Chowdhury	2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/468,818.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/468,818, filed on 12/22/1999. ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Product-by-Process Limitations.

4. While not objectionable, the Office reminds Applicant that "product by process" limitations in claims drawn to structure are directed to the product, per se, no matter how actually made. *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also, *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPAQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wethheim*, 191 USPAQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al.*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that is is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or otherwise.

Note that applicant has the burden of proof in such cases, as the above case law makes clear.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 21, 25, 26, 31, 34, 35, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimoda et al., (Shimoda), USPAT 5,705,632.**

7. Shimoda discloses (col. 1, line 10 – col. 2, line 67), a cellulose acetate film comprising cellulose acetate, wherein the cellulose acetate has an acetic acid content of 58% or more and wherein the film is formed by a solvent casting method using a cellulose acetate solution that is prepared according to a cooling dissolution method wherein the cooling dissolution method uses a halogenated hydrocarbon such as methylene chloride as a solvent.

Accordingly, claims 21, 25, 26, 31, 34, 35, 40 and 41 are anticipated.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 22-24, 27-29, 32, 33, 36-38 and 42-44 are rejected under 35 U.S.C 103 (a) as being unpatentable over Shimoda.

11. As to claims 22-24, 32 and 33, it is known in the art that stretching treatment of a cellulose acetate film is carried out in order to control its retardation and the stretch ratio is desirably 3-100%. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to stretch the cellulose acetate film at a desirable stretch ratio such as 10-30% in either the length or width direction to control its retardation and thus to obtain an efficient film.

As to claims 27, 36 and 42, it is typical for a cellulose acetate film to contain a compound having at least two aromatic rings in an amount of 0.3 to 20 weight parts based on 100 weight parts of the cellulose acetate for several advantages such as to provide better display performance.

As to claims 28, 29, 37, 38, 43 and 44, Shimoda does not explicitly disclose the limitations such as immersing a surface of the film in an alkali solution or spraying the

surface with an alkali solution. However, it is common and known in the art that for efficiently saponifying the film it is preferred to apply an alkali solution onto the cellulose acetate film. Further, it is also known that if the saponification is performed by applying the alkali solution preferably has good wettability onto the cellulose acetate film. Further, spraying or immersing the surface of the film is a known way of applying the solution. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to immerse the surface of the film in an alkali solution or spraying the surface of the film with an alkali solution since performing the saponification by applying alkali solution provides good wettability onto the cellulose acetate film.

12. Claims 30, 39 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoda in view of Braudy et al., (Barudy), USPAT 3,978,247.

13. Shimoda differs from the claimed invention because he does not explicitly disclose that the surface of the cellulose acetate film is subject to corona discharge treatment.

Braudy discloses a film that is made of cellulose acetate (col. 6, lines 18-20). Braudy also discloses that when such films go through corona discharge treatment it improves adhesion.

Braudy is evidence that ordinary workers in the art would find a reason, suggestion or motivation to use a cellulose acetate film that go through corona discharge treatment.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention was made to have the cellulose acetate film of Shimoda to go through corona discharge treatment for advantages such as improved adhesion, as per the teachings of Braudy.

Accordingly, claims 30, 39 and 45 would have been obvious.

Response to Arguments

14. Considering applicant's remarks filed on 10/14/04, the examiner is withdrawing the previous office action mailed on 07/14/04. Thus the instant office action is made non-final.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tarifur R Chowdhury whose telephone number is (571) 272-2287. The examiner can normally be reached on M-Th (6:30-5:00) Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim can be reached on (571) 272-2293. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TRC
December 13, 2004

TARIFUR R. CHOWDHURY
PRIMARY EXAMINER